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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/506,434 02/18/00 ACHARYA

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021967
HUNTON AND WILLIAMS
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WASHINGTON DC 20006

TM02/0731

EXAMINER

BERGIN, I

ART UNIT

PAPER NUMBER

2164
DATE MAILED:

07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/506,434

Applicant(s)

ACHARYA ET AL.

Examiner

James S. Bergin

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24 and 27-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 18 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,8. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1(A), wherein the remote customer terminal comprises a telephone, as claimed in claim 2.

Species 1(B), wherein the remote customer terminal comprises a facsimile machine, as claimed in claim 3.

X Species 1(C), wherein the remote customer terminal comprises a personal computer, as claimed in claim 4.

Species 1(D), wherein the remote customer terminal comprises an automated teller machine, as claimed in claim 5.

Species 2(A), wherein the remote customer terminal comprises a keypad for data entry, as claimed in claim 6.

Species 2(B), wherein the remote customer terminal comprises a keyboard for data entry, as claimed in claim 7.

Species 2(C), wherein the remote customer terminal comprises a microphone for data entry, as claimed in claim 8.

Species 2(D), wherein the remote customer terminal comprises a magnetic ink character reader for data entry, as claimed in claim 9.

X Species 2(E), wherein the remote customer terminal comprises a digital image scanner for data entry, as claimed in claims 10-12 (note that claims 11 and 12 are ~~A~~

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alternate subspecies and if species 2E is selected, then either the subspecies of claim 11 or the subspecies of claim 12 should be selected).

Species 3(A), wherein the result of the transaction in step (e) comprises a credit to the bank customer's account, as claimed in claim 16.

Species 3(B), wherein the result of the transaction in step (e) comprises a provisional credit to the bank customer's account, as claimed in claim 17.

Species 3(C), wherein the result of the transaction in step (e) comprises denial, as claimed in claim 18.

Species 3(D), wherein the result of the transaction in step (e) comprises marking a check to prevent deposit, as claimed in claims 19 and 28.

Species 3(E), wherein the result of the transaction in step (e) comprises physical capture of the paper check to prevent redeposit, as claimed in claims 20 and 29.

Species 3(F), wherein the processing in step (d) comprises electronic funds transfer, as claimed in claim 22.

Species 3(G), wherein the processing in step (d) comprises electronic check presentment, as claimed in claim 23.

Species 3(H), wherein the processing in step (d) comprises printing a reconstructed check and physically routing the reconstructed check to the paying bank for payment, as claimed in claims 24 and 27.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. **In this instance the applicant must select one of**

species 1 (A-D) and one of species 2 (A-E) and one of species 3 (A-H). Currently, claims 1, 15 and 21 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Information Disclosure Statement

2. Please note that copies of references U20-U140, P1 and P2, which were listed on FORM PTO-1449 filed 1/23/2001 (paper 8), were not received by the examiner and have therefore not been considered at this time. References U1-U19 (of the same

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FORM PTO-1449 filed 1/23/2001 (paper 8)) were received and have been considered by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 7, 10-16, 19-22, 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Riach et al. (5,751,842).

Riach et al. disclose a check depositing system and method comprising a remote processing terminal 10, connected to data processing circuitry suitable for electronic funds transfer whereby the customer's bank account can be automatically credited with the monetary value of a conventional check (column 2, lines 18-28). The customer logs on to the automated banking system using a bankcard and pin number and is authorized to continue. The customer enters information from the check into the customer terminal using the keyboard 14 (column 4, lines 30-34). A funds transfer operation is effected wherein the value of the check is transferred from the payer's account to the payee's account (column 4, lines 39-47 and claim 1), this process including the check clearing process.

Regarding claim 7, Riach et al. disclose the keyboard 14.

Regarding claims 10-12, Riach et al. disclose digital image lift device 38 (column 12, lines 7-34).

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Regarding claims 13, 19 and 28, Riach et al. disclose a printer for issuing receipts 300 from the slot 17. Riach et al. system also endorses the check by printing 252 (column 4, lines 35-39) so as to prevent redeposit.

Regarding claims 14, 20 and 29, Riach et al. disclose the vaults 52-56 for physical capture of the check (column 4, lines 45-47).

Regarding claim 22, Riach et al. disclose electronic funds transfer (column 2, line 25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-6, 8, 9, 17, 18, 23, 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riach et al. (5,751,842).

Riach et al. disclose a check depositing system and method as described above. However, the Riach et al. disclosure does not specifically mention the limitations of the claims 2-6, 8, 9, 17, 18, 23, 24 and 27. The examiner takes official notice that the limitations of claims 2-6, 8, 9, 17, 18, 23, 24 and 27 include only that, which was notoriously well known by those of ordinary skill in the electronic banking art at the time that the invention was made. It would therefore have been obvious to one of ordinary skill in the art at the time that the invention was made, to include any or all of the limitations of claims 2-6, 8, 9, 17, 18, 23, 24 and 27 in the Riach et al. check depositing

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system and method, as in doing so, one of ordinary skill would simply be availing of notoriously well known features and method steps in the field of electronic banking.

Conclusion

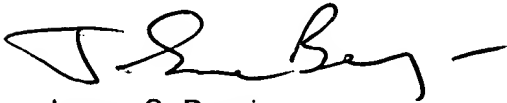
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shah (6,129,273) and Stinson et al. (6,149,056) disclose relevant automated check cashing systems; Bednar et al. disclose an image processing and retrieval system in a check cashing application; Slater (EP 0 984,410 A1) discloses a check imaging and scanning system wherein the check image is transmitted electronically to a central location wherein it may be recreated in paper form.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Bergin whose telephone number is 703 308-8549. The examiner can normally be reached on Monday-Thursday 8.30-6.00 and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308-1396 for regular communications and 703 308-1396 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.



James S. Bergin

July 28, 2001



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100